

Application No. 09/943,670
Amendment dated November 10, 2003
Reply to Office Action May 8, 2003

REMARKS

Claims 1-11 appear in this application for the Examiner's review and consideration. Applicant respectfully requests reconsideration of this application. Claim 4 has been amended to correct a typographical error.

The Examiner rejected claims 1-7 and 10 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,167,523 to Strong in view of U.S. Patent No. 6,269,399 to Dyson et al. (hereinafter "Dyson"). Applicants respectfully traverse these rejections.

Independent claim 1 recites, inter alia, "selecting a document to be completed by more than one party", "providing at least one request to a first user at a first location on a computer network for information used to complete the document", "providing at least one request to a second user at a second location on the computer network for information used to complete the document" and "writing information obtained from the first and second users used to complete the document onto at least one digital file."

With respect to claim 1, the Examiner states on pages 2-3 of the Office Action that Strong teaches "selecting a document to be completed by more than one party" that "Strong does not expressly disclose a second user at a second location" that "Dyson et al. discloses a second user a second location" and that "it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Strong to include a second user at a second location."

Applicants respectfully submit that neither Strong nor Dyson taken alone or in combination render the foregoing rejected claim obvious for at least the reasons set forth below.

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With respect to claim 1, applicants respectfully submit that Strong does not teach “selecting a document to be completed by more than one party” as recited. According to the presently claimed invention, a document may be interactively processed over a computer network by more than one party. In contrast, Strong does not teach interactively processing the same document over a computer network by more than one party. Rather, Strong, at most, merely states that electronic forms may be filled out by users (col. 1, lines 13-15) but does not teach or suggest a method in which the same document is completed by more than one party.

Further, with respect to claim 1, the Examiner acknowledges on page 3 of the Office Action that Strong does not disclose a method of interactive processing of a document to be completed by more than one party over a computer network in which there is a second user at a second location who provides information used to complete an electronic document. Applicants respectfully submit that it would not have been obvious to a person having ordinary skill in the art to have modified the method disclosed in Strong in view of the disclosure in Dyson to arrive at the claimed invention. “Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.” In re Fitch, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) quoting ACS Hosp. Systems, Inc. v. Montefiore Hosp., 221 USPQ 929, 933 (Fed. Cir. 1984) (emphasis in original).

Applicants respectfully submit that there is no teaching or suggestion in the prior art relied upon by the Examiner to modify the method disclosed in Strong to arrive at the claimed

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invention of claim 1 in which there is a second user at a second location who provides information used to complete an electronic document. First, the Strong and Dyson references are so unrelated that - absent hindsight - a person having ordinary skill in the art of the presently claimed invention would have no motivation to combine the references. Strong indicates that it "relates to the field of processing of electronic forms" (col. 1, lines 6-7) whereas Dyson relates to a different field, i.e., "communication systems" generally (col. 1, lines 5-6) and more specifically "a system and method for exchanging information between a first telecommunications party and a second telecommunications party" (col. 1, lines 30-33). Moreover, there is no teaching or suggestion in Dyson about completion of form documents over a computer network, let alone any teaching or suggestion about completion of a form document in which one user completes part of the form at one location and a second user completes another section of the form at another location.

While the Examiner states that it would have been obvious to modify Strong by the teachings of Dyson "because a second user at a second location, enables in exchanging information where both the parties (i.e. first and the second) need to provide input towards completion of a form or a document" referring to column 6, lines 49-53 in Dyson, applicants respectfully submit that the disclosure in Dyson relied upon by the Examiner merely refers to "exchanging information between first and second telecommunications parties" and has nothing to do with selecting a form to be completed by first and second users. One of ordinary skill in the art would not be motivated to modify the method described in Strong to add a second user at a second location to complete a form document based on any teaching in Dyson because the

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teachings in Dyson are unrelated to processing form documents and entering information into that document over a computer network by different users at different locations.

Therefore, absent hindsight, there is no reason a person of ordinary skill in the art would look or even know to look to the disclosure in Dyson for guidance in designing a system for processing electronic documents. See Fitch, 23 USPQ2d at 1783 (“The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification . . . It is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious.”)

Because the teachings in Dyson would not motivate a person of ordinary skill in the art to modify the method in Strong to arrive at the recited invention of claim 1 in which there is a second user at a second location who provides information used to complete an electronic document, it is respectfully submitted that claim 1 is not taught by Strong or Dyson, either alone or in combination. Accordingly, applicants respectfully submit that the claimed invention of independent claim 1 is not rendered obvious by Strong in view of Dyson and further respectfully request that the claim rejection under 35 U.S.C. 103 be withdrawn for the foregoing reasons.

Claims 2-7 each ultimately depend from claim 1. Applicants respectfully submit that because claims 2-7 ultimately depend from claim 1, claims 2-7 are not rendered obvious by Strong in view of Dyson for at least the reasons claim 1 is not rendered obvious by these references as discussed above. Accordingly, applicants respectfully request that these claim rejections under 35 U.S.C. 103 with respect to claims 2-7 be withdrawn.

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Independent claim 10 recites, inter alia, to “send at least one request associated with the selected document to a second user at a second location on a computer network”, “receive at least one response to the at least one request from the second user; and write information obtained from the at least one response from the first and second users onto the at least one digital file.”

The Examiner states on page 6 of the Office Action that Strong does not disclose a second user at a second location, that Dyson discloses a second user at a second location and “it would have been obvious to a person having ordinary skill in the art . . . to have modified Strong to include a second user at a second location.” Applicants respectfully submit that it would not have been obvious to a person having ordinary skill in the art to have modified the method disclosed in Strong in view of the disclosure in Dyson to arrive at the recited invention in claim 10 in which there is a second user at a second location who provides information used to complete an electronic document for the same reasons that it would not have been obvious to have modified the method disclosed in Strong in view of the disclosure in Dyson to arrive at the recited invention in claim 1. Accordingly, applicants respectfully submit that the claimed invention of independent claim 10 is not rendered obvious by Strong in view of Dyson and further respectfully requests that the claim rejection under 35 U.S.C. 103 be withdrawn.

The Examiner rejected claims 8, 9 and 11 under 35 U.S.C. 103(a) as being unpatentable over Strong in view of Dyson and further in view of U.S. Patent No. 6,327,656 to Zabetian. Applicants respectfully traverse these rejections.

Independent claim 8 recites, inter alia, “selecting a document to be completed by more than one party”, “providing at least one request to a second user at a second location on the

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computer network for information used to complete the document”, “writing information obtained from the at least one response from the first and second users onto at least one digital file” and “upon the recognition of an occurrence of an event on the computer network, a digital signature routine is performed . . . to obtain a digital signature of the at least one digital file and wherein a time stamp corresponding to the time of the recognition of the occurrence of the event is created, the digital signature and time stamp being sent to a remote location.”

Applicant respectfully submits that neither Strong nor Dyson nor Zabetian, taken alone or in combination render the foregoing rejected claim 8 obvious for at least the reasons set forth below.

First, with respect to claim 8, none of the prior art relied upon by the Examiner teaches “selecting a document to be completed by more than one party” as recited. According to the presently claimed invention, a document may be interactively processed over a computer network by more than one party. In contrast, Strong does not teach interactively processing the same document over a computer network by more than one party. Rather, Strong at most merely states that electronic forms may be filled out by users (col. 1, lines 13-15) but does not teach or suggest a method in which the same document is completed by more than one party.

The Examiner states on page 8 of the Office Action that Strong does not teach a second user at a second location, that Dyson teaches a second user at a second location and “it would have been obvious to a person having ordinary skill in the art . . . to have modified Strong to include a second user at a second location” in view of the teachings of Dyson. Applicants respectfully submit that it would not have been obvious to a person having ordinary skill in the

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art to have modified the method disclosed in Strong in view of the disclosure in Dyson to arrive at the recited invention in claim 8 in which there is a second user at a second location who provides information used to complete an electronic document for the same reasons that it would not have obvious to have modified the method disclosed in Strong in view of the disclosure in Dyson to arrive at the recited invention in claim 1. Accordingly, applicants respectfully submit that the claimed invention of independent claim 8 is not rendered obvious by Strong in view of Dyson and further respectfully request that the claim rejection under 35 U.S.C. 103 be withdrawn.

Moreover, neither Strong, nor Dyson, nor Zabetian, taken alone or in combination teach a method of interactive processing of a document “wherein upon the recognition of an occurrence of an event on the computer network, a digital signature routine is performed on the at least one digital file” and “wherein a time stamp corresponding to the time of recognition of the occurrence of the event is created.” It is respectfully submitted that the disclosure in Zabetian referred by the Examiner does not teach or suggest these limitations as recited in claim 8. For example, Zabetian does not teach or suggest a method of processing an electronic document in which recognizes the occurrence of some event on the computer network that causes a digital signature to be performed on the at least one digital file having information obtained from either or both the first and second users completing the form document. Rather, Zabetian merely refers to a method for electronic document certification in which the user him or herself registers a document by taking the document that he or she wants verified and then sending a request for certification and document itself to the certification provider. See, e.g., col. 2, lines 2-4 (“The

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certification provider receives the party's request for certification, along with the electronic document to be certified"). Thus, Zabetian does not teach or suggest "recognition of an occurrence of an event on the computer network" as part of the method of interactive processing of a document to being completed by more than one party but merely discloses that a party can send an electronic document to a certification provider if that party decides that it wants to register the document.

Moreover, it is respectfully submitted that there is no teaching or suggestion to combine Strong, Dyson and Zabetian to arrive at the invention recited in claim 8 for the same reasons that the Strong and Dyson references cannot be combined to arrive at the invention recited in claim 1 as discussed above and for the additional reason that Zabetian does not teach performing a digital signature or creating a time stamp in connection with a form document as or upon it being completed by even one user, let alone by two users at two locations. Zabetian does not teach or suggest performing a digital signature or creating a time stamp in connection with a method for completing a form document but merely indicates that a party in possession of an electronic document may certify that document by sending it to the certification provider to have certified. Advantageously, applicants presently claimed invention of claim 8 allows the information associated with the form document being completed to be verified and time stamped to guard against tampering with the form document. This step can be applied once or at various stages of the document's completion. Further, this step may be performed automatically upon the occurrence of some event (e.g., after each user submits a last response for the form document being completed).

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Accordingly, applicants respectfully submit that the claimed invention of independent claim 8 is not rendered obvious by Strong in view of Dyson and further in view of Zabetian and applicants further respectfully request that the claim rejection under 35 U.S.C. 103 be withdrawn.

Independent claim 9 recites, inter alia, “selecting a document to be completed by more than one party”, “performing a first digital signature routine on the at least one digital file to obtain a first digital signature of the at least one digital file”, “creating a first time stamp corresponding to the time of submission of the information obtained from the at least one response from the first user”, “writing information obtained from the at least one response from the second user onto the at least one digital file”, “performing a second digital signature routine on the at least one digital file to obtain a second digital signature of the at least one digital file” and “creating a second time stamp corresponding to the time of submission of the information obtained from the at least one response from the second user . . .”

Applicants respectfully submit that neither Strong nor Dyson nor Zabetian, taken alone or in combination, render the foregoing rejected claim 9 obvious for at least the reasons set forth below.

First, with respect to claim 9, none of the prior art relied upon by the Examiner teaches “selecting a document to be completed by more than one party” as recited. According to the presently claimed invention, a document may be interactively processed over a computer network by more than one party. In contrast, Strong does not teach interactively processing the same document over a computer network by more than one party. Rather, Strong at most merely

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states that electronic forms may be filled out by users (col. 1, lines 13-15) but does not teach or suggest a method in which the same document is completed by more than one party.

The Examiner states on page 10 of the Office Action that Strong does not teach a second user at a second location, that Dyson teaches a second user at a second location and “it would have been obvious to a person having ordinary skill in the art . . . to have modified Strong to include a second user” in view of the teachings of Dyson. Applicants respectfully submit that it would not have been obvious to a person having ordinary skill in the art to have modified the method disclosed in Strong in view of the disclosure in Dyson to arrive at the recited invention in claim 9 in which there is a second user at a second location who provides information used to complete an electronic document for the same reasons that it would not have obvious to have modified the method disclosed in Strong in view of the disclosure in Dyson to arrive at the recited invention in claim 1. Accordingly, applicants respectfully submit that the claimed invention of independent claim 9 is not rendered obvious by Strong in view of Dyson and further respectfully requests that the claim rejection under 35 U.S.C. 103 be withdrawn.

Moreover, neither Strong, nor Dyson, nor Zabetian, taken alone or in combination teach a method of interactive processing of a document that “perform[s] a first digital signature routine on the at least one digital file to obtain a first digital signature of the at least one digital file”, “creat[es] a first time stamp corresponding to the time of submission of the information obtained from the at least one response from the first user”, “perform[s] a second digital signature routine on the at least one digital file to obtain a second digital signature of the at least one digital file”

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and "creat[es] a second time stamp corresponding to the time of submission of the information . . ."

It is respectfully submitted that the disclosure in Zabetian relied upon by the Examiner does not teach or suggest these limitations as recited in claim 9. Rather, the disclosure relied upon by the Examiner (e.g., col. 13, line 38 through col. 14, lines 15) merely states that a signature extracted from the subject document (for which verification is sought) is compared with the signature extracted from the document when certification was provided. It does not does not teach or suggest a method of processing an electronic document in which a first a digital signature and time stamp are obtained in connection with a form document that is being completed and in which a second digital signature and time stamp are obtained in connection with the same form document that is being completed.

Thus, Zabetian merely indicates that signatures extracted from two documents can be compared to verify if they are the same document. In contrast, the presently claimed invention of claim 9 allows the information associated with the form document being completed to be verified and dated to guard against tampering with the form document as part of the method of processing the form document. This step can be applied one or at various stages of the document's completion (e.g., after each user submits the last response to the form document being completed). Accordingly, applicants respectfully submit that the claimed invention of independent claim 9 is not rendered obvious by Strong in view of Dyson and further in view of Zabetian and further respectfully request that the claim rejection under 35 U.S.C. 103 be withdrawn

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Independent claim 11 recites, inter alia, to “determine a first time stamp from the timing device corresponding to the receipt of the at least one response to the at least one request from the first user”, “perform a first digital signature routine on the at least one digital file . . .”, “write information obtained from the at least one response from the second user onto at least one digital file”, “determine a second time stamp from the timing device corresponding to the receipt of the at least one response to the at least one request from the second user” and “perform a second digital signature routine on the at least one digital file to obtain an original digital signature . . .”

Applicants respectfully submits that neither Strong nor Dyson nor Zabetian, taken alone or in combination render the foregoing rejected claim 11 obvious for at least the reasons set forth below.

The Examiner states on page 13 of the Office Action that Strong does not disclose a second user at a second location, that Dyson discloses a second user at a second location and “it would have been obvious to a person having ordinary skill in the art . . . to have modified Strong to include a second user” in view of the teachings of Dyson. Applicants respectfully submit that it would not have been obvious to a person having ordinary skill in the art to have modified the method disclosed in Strong in view of the disclosure in Dyson to arrive at the recited invention in claim 11 in which there is a second user at a second location who provides information used to complete an electronic document for the same reasons that it would not have obvious to have modified the method disclosed in Strong in view of the disclosure in Dyson to arrive at the recited invention in claim 1. Accordingly, applicants respectfully submit that the claimed

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invention of independent claim 11 is not rendered obvious by Strong in view of Dyson and further respectfully requests that the claim rejection under 35 U.S.C. 103 be withdrawn.

Moreover, neither Strong, nor Dyson, nor Zabetian, taken alone or in combination teach a method of interactive processing of a document that “determine[s] a first time stamp from the timing device corresponding to the receipt of the least one response to the at least one request from the first user”, “perform[s] a first digital signature routine on the at least one digital file to obtain an original digital signature”, “determine[s] a second time stamp from the timing device corresponding to the receipt of the at least one response to the at least one request from the second user” and “perform[s] a second digital signature routine on the at least one digital file to obtain an original digital signature . . .” It is respectfully submitted that the disclosure in Zabetian referred by the Examiner does not teach or suggest these limitations as recited in claim 11 for the same reasons that Zabetian does not teach or suggest performing first and second digital signature routines on the at least one digital file and creating first and second time stamps corresponding to the information received from the first and second users as discussed above with respect to claim 9. Applicants respectfully submit that the disclosure is Zabetian relied upon by the Examiner (e.g., col. 13, line 38 through col. 14, lines 15) merely states that a signature extracted from the subject document (for which verification is sought) may be compared to the signature extracted from the document when certification was provided. It does not does not teach or suggest a method of processing an electronic document in which a first digital signature and time stamp are obtained in connection with a form document that is being

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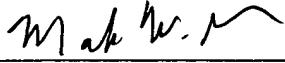
completed and in which a second digital signature and time stamp are obtained in connection with the same form document that is being completed the second party to the form document.

Accordingly, applicants respectfully submit that the claimed invention of independent claim 11 is not rendered obvious by Strong in view of Dyson and further in view of Zabetian and further respectfully requests that the claim rejection under 35 U.S.C. 103 be withdrawn.

In view of the foregoing, applicants therefore respectfully submit that the rejection of claims 1-11 under 35 U.S.C. 103(a) has been overcome. Claims 1 – 11 are believed to be in condition for allowance, which allowance is respectfully requested. The Commissioner is authorized to charge any fees that may be required in connection with this response to Deposit Account No. 50-0521 for any matter in connection with this response, including any fee for extension, which may be required.

Respectfully submitted,

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